

PATENT

Application No.: 09/597,801
Attorney Docket No.: 00-032**REMARKS**

Prior to entry of this Amendment:

- Claims 1-29 and 72-91 were pending in the present application
- Claims 1-29 and 72-91 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 6-9, 73-85, and 88-98 will be pending (28 total claims)
- Claims 6, 8, 73, 79-81, and 88 will be amended
- Claims 1-5, 10-29, 72, 86, and 87 will be canceled
- Claims 92-98 will be added
- Claims 6, 8, 73, 79-81, 88, 92, 93, 95, 96, and 98 will be the only independent claims (12 independent claims)

A. Claim Amendments**1. Claims 1-5, 10-29, 72, 86, and 87 have been canceled**

Claims 1-5, 10-29, 72, 86, and 87 have been canceled without prejudice. We submit that Claims 1-5, 10-29, 72, 86, and 87 contain allowable subject matter, and that Claims 1-5, 10-29, 72, 86, and 87 have been canceled solely in order to expedite issuance of the present application. We intend to pursue the subject matter of the canceled claims in a continuing application.

2. Claims 6, 8, 73, 79-81, and 88 are now independent

Claims 6, 8, 73, 79-81, and 88 are now independent claims. Each has been amended to incorporate all of the limitations of canceled Claim 1.

No new matter has been added. Each of independent Claims 6, 8, 73, 79-81, and 88 contains allowable subject matter, as discussed below.

3. Claim 80 has been amended to recite *cashing in of the gaming token*

No new matter has been added. Claim 80 now recites wherein the detected event is cashing in of the gaming token. Claim 80 contains allowable subject matter, as discussed below. We intend to pursue the subject matter of Claim 80, as originally filed, in a continuing application.

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No new matter has been added. New Claims 92, 93, 95, 96 and 98 are independent claims. New Claims 94 and 97 depend from Claims 94 and 96, respectively.

Each of new Claims 92-98 contains allowable subject matter, as discussed below.

B. Section 103(a) Rejection

Claims 1-12, 14-16, 18-29, 72, 80, and 86 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,264,109 issued to Chapet et al. ("Chapet"), and further in view of U.S. Patent No. 6,050,487 issued to Bonifas, et al. ("Bonifas").

Claims 13, 17, 73-78, 81, 82, and 87-91 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapet in view of Bonifas and further in view of U.S. Patent No. 5,361,885 issued to Modler ("Modler").

Claim 79 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapet in view of Bonifas and further in view of U.S. Patent No. 5,706,925 issued to Orus et al. ("Orus").

Claims 83-85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chapet in view of Bonifas and Modler, and further in view of Orus.

We respectfully traverse the Examiner's Section 103(a) rejections.

1. Claims 1-5, 10-29, 72, 86, and 87 have been canceled

Accordingly, the Section 103(a) rejections of the canceled claims is moot. However, where deemed relevant to currently amended and / or new claims, we have disputed assertions made by the Examiner with respect to canceled claims. We also submit that the Examiner failed to establish *prima facie* case of obviousness for any claim, due at least a failure to define a level of ordinary skill in the art, as discussed below.

2. Factual Inquiries Required by *Graham* for Determination of Obviousness Under 35 U.S.C. § 103

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. U.S. Patent and Trademark Office policy is to

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follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 (8th ed. (Rev. 1), Feb. 2003).

The four factual inquiries enunciated in Graham as a background for determining obviousness of a claim are as follows:

- (A) **Resolving the level of ordinary skill in the pertinent art;**
- (B) Determining the scope and contents of the prior art;
- (C) Ascertaining the differences between the prior art and the claims in issue; and
- (D) Evaluating evidence of secondary considerations.

M.P.E.P. § 2141.

3. Level of Ordinary Skill in the Art

Ascertaining a level of ordinary skill in the art is thus necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) ("Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered."). Some factors that may be considered are outlined at M.P.E.P. § 2141.03.

Without a factual determination of the level of ordinary skill in the art, obviousness cannot be assessed properly because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986).

Thus, a determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000) (citing Custom Accessories, 807 F.2d at 962).

4. Prima Facie Case of Obviousness

In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious to the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. M.P.E.P. § 2142.

(a) Basic Requirements

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To establish a *prima facie* case of obviousness for a claim, three basic criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
2. There must be some reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01.

(b) The Examiner Bears the Initial Burden of Factual Support

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142. The initial burden, therefore, is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. § 2142.

5. The Examiner has Failed to Define a Level of Ordinary Skill in the Art as Required by *Graham*

We have carefully reviewed the Section 103 rejections in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.

Specifically, the Examiner has neither

- (i) defined a level of ordinary skill in the art, nor
- (ii) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary

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skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited references and the claims objectively.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

6. Request for Factual Support

In any subsequent Office Action asserting a Section 103 rejection, we respectfully request that the Examiner clearly indicate, with respect to each rejected claim, the support in the record for any findings under the required Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations.

In particular, we respectfully request that the Examiner define and submit evidence of the level of ordinary skill.

Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

7. The Examiner has Failed to Meet the Basic Criteria for Prima Facie Obviousness

The Examiner has failed to make the requisite factual findings required under Graham (outlined above) and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

Some additional criteria that have not been met with respect to particular claims are discussed further herein.

8. Withdrawal / Clarification of Previous argument

In the present rejection the Examiner repeats a prior assertion that the "chip card" of Bonifas is a "gaming chip." The Examiner refers to Bonifas as disclosing

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a “gaming chip in the form of a card containing an electronic chip,” and repeatedly refers to the Bonifas card in the Office Action as a “gaming chip” or “gaming token.” [Office Action, page 3; see also, e.g., page 4 (“Bonifas discloses various detectable events capable of changing the value of the gaming chip/token....” (emphasis added))].

We had previously asserted that the “chip” card of Bonifas does not suggest the recited *gaming token* or changing the value of a *gaming token*. [Response mailed November 3, 2003, pages 2, 3-4]. According to the Examiner, our representative also argued that “Applicant’s invention is directed to a gaming token and not to a smart card.” [Examiner’s Interview Summary mailed November 26, 2003].

We respectfully withdraw these arguments. They are not relied upon here in traversing the present rejections.

Further, we wish to clarify for the record that as disclosed our recited term *gaming token* may include, among other things, “a casino chip or other object issued by a casino for betting in a table game of chance or in a gaming device....” [Specification, page 8, lines 6-7 (emphasis added)].

We do not disclaim a reading of the recited *gaming token* in the present claims that would include embodiment as a card, chip or other object. We also intend to file claims in a continuing application in which the term *gaming token* may encompass embodiments including casino chips or other objects, as described in the Specification.

We do not believe that the Examiner has relied upon our previous arguments, now withdrawn. Specifically, it is our understanding that the Examiner is still relying on her initial interpretation of the “card” of Bonifas as teaching a “gaming chip” or “gaming token.” Accordingly, we understand that the withdrawn arguments have not prejudiced the examination of the pending claims.

If the Examiner would like to discuss our withdrawal / clarification of this argument further, we invite the Examiner to contact our representative.

9. Claims 6 and 7

Claim 6 is now independent and includes all of the limitations of canceled Claim 1. Claim 7 depends from Claim 6.

None of the cited references, alone or in combination, suggests the desirability of changing the value of a *gaming token in response to detecting that a*

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player has played a gaming device for a period of time, as generally recited in Claim 6. The Examiner does not assert otherwise.

In fact, the Examiner has never cited any reference or otherwise provided substantial evidence of the desirability of such a feature. Accordingly, the Examiner has never established a *prima facie* case of obviousness of Claim 6.

In the present Office Action, the Examiner merely asserts "one of skill in the art would have been motivated to configure the system as such in order to encourage long period of play." [page 4]. This is an improper factual finding. It is a conclusory statement unsupported by any evidence, much less substantial evidence. The Examiner has merely noted what the Examiner believes is a benefit of Claim 6.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 6 (or dependent Claim 7).

10. Claims 8 and 9

Claim 8 is now independent and includes all of the limitations of canceled Claim 1. Claim 9 depends from Claim 8.

None of the cited references, alone or in combination, suggests the desirability of changing the value of *a gaming token in response to detecting that a player has played a gaming device a number of times*, as generally recited in Claim 8. The Examiner does not assert otherwise.

In fact, the Examiner has never cited any reference or otherwise provided substantial evidence of the desirability of such a feature. Accordingly, the Examiner has never established a *prima facie* case of obviousness of Claim 8.

In the present Office Action, the Examiner merely asserts "Bonifas discloses various detectable events..." and that the recited feature "would have been obvious matter of design choice." [page 4]. This is an improper factual finding. To state that something is "an obvious matter of design choice" is a conclusion, not evidence. Further, even if Bonifas describes "various detectable events," none of them suggests *a number of times a player has played a gaming device*, much less the desirability of changing the value associated with a gaming token in response to detecting the number of times a player has played a gaming device. The Examiner does not assert otherwise. The rejection is a conclusory statement unsupported by any evidence, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 8 (or dependent Claim 9).

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Claim 80 is now independent and includes all of the limitations of canceled Claim 1.

Claim 80 now recites *wherein the detected event is cashing in of the gaming token*. Bonifas is devoid of any hint of cashing in of the described "card," much less changing the value associated with the card when it is cashed in.

In contrast, various embodiments of the present invention provide for associating a different value with a gaming token when it is cashed in (e.g., at a cashier facility). [See, e.g., Specification, page 25, lines 20-22]. None of the cited references, alone or in combination, suggests the desirability of *wherein the detected event is cashing in of the gaming token*, as generally recited in Claim 80.

Accordingly, we submit that Claim 80 contains allowable subject matter.

12. Claims 81-85

Claim 81 is now independent and includes all of the limitations of canceled Claim 1. Claims 82-85 depend from Claim 81.

None of the cited references, alone or in combination, suggests the feature of *determining on the basis of the read token identifier whether a prize has been won*, as recited in Claim 81.

The Examiner asserts that Bonifas teaches this feature. We disagree. The cited portion of Bonifas has nothing to do with determining whether a prize has been won, much less determining *based on the read token identifier*.

No reference suggests the desirability of providing for such a feature.

In contrast, various embodiments of the present invention allow a player to win a prize based on the identity of the token. For example, a slot machine or other gaming device may read an inserted token and determine, based on the token identifier for the token, whether it is a prize winning token. [See, e.g., page 30, lines 10-28 (describing an exemplary "lucky token" drawing game); page 31, lines 16-29; page 32, lines 1-12].

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 81 (or dependent Claims 82-85).

13. Claims 88-91

Claim 88 is now independent and includes all of the limitations of canceled Claim 1. Claims 89-91 depend from Claim 88.

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None of the cited references, alone or in combination, suggests the features of *a gaming token including a display, using the display of the gaming token to display information, and determining an outcome of a game based on the displayed information*, as recited in Claim 88.

The Examiner rejects Claims 88-91 but has failed to address the above features. Specifically, the Examiner has failed to recognize that determining an outcome of a game is based on displayed information, information displayed using a display of a gaming token. We disagree that Bonifas or any other cited references suggests any such features. The portion of Bonifas cited in rejecting Claim 88 has nothing to do with *determining an outcome of a game*, much less *determining an outcome of a game based on information displayed on a display, in which a gaming token includes the display*.

No reference suggests the desirability of providing for such features. Bonifas does not suggest that the described "card" includes a display (the display referred to by the Examiner is of the described card-reader device). Several of the references suggest gaming tokens have "face values" or static indications of a value of gaming token. However, there is no evidence of determining an outcome of a game based on information displayed on a gaming token.

In contrast, various embodiments of the present invention allow for information to be displayed using a display of a gaming token, and determining an outcome of a game based on the displayed information. For example, a gaming token may display bingo numbers for bingo game, random numbers for a matching game, etc. [See, e.g., page 5, lines 1-5; page 29, lines 4-27]. This advantageously allows for one or more secondary games (e.g., in addition to using tokens for play of slot machine games) to be provided using gaming tokens in accordance with the present invention.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 88 (or dependent Claims 89-91).

Further with respect to Claims 90 and 91, the Examiner merely asserts: "Slot machines are known to incorporate various types of games such as bingo or drawing game." The Examiner has not supported this assertion with any evidence, and thus has failed to establish a *prima facie* case of obviousness of Claims 90 and 91. Even if this assertion is true, however, the Examiner has not provided any evidence that it was known or suggested to use information displayed using a gaming token (e.g., a bingo number) in determining an outcome of a game, much less a bingo game or drawing game. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claims 90-91.

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Claim 73 is now independent and includes all of the limitations of canceled Claim 1. Claims 74-78 depend from Claim 73.

None of the cited references, alone or in combination, suggests *in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status*, as recited in Claim 73.

In the present Office Action, the Examiner asserts that Modler discloses “displaying the value [of a gambling chip] on the top surface.” [page 6]. We note that the Modler display does not suggest a display device that is switchable, or a display device that is switchable between two different display statuses. As described in Modler, the displayed value of the gambling chip appears to be fixed (e.g. at the time of manufacture. [See, e.g., FIGS. 2, 3]. If the Examiner disagrees, please clarify.

The Examiner also asserts that Bonifas discloses recording a different value of the described “card” in a memory of the “card” when the value changes. This does not, however, suggest a display device that is switchable, or a display device that is switchable between two different display statuses. We request that the Examiner clarify the basis for the rejection of Claim 73.

The Examiner simply concludes that it would have been obvious to have a display device that is switchable because Bonifas discloses recording a change in value on the “card.” There is no hint in Bonifas, however, that the “card” may include a display device, or that such a display would be desirable in the “card.” To the contrary, the Bonifas system relies on the described “card reader” for displaying the value of a “card.” The proposed modification of the Bonifas “card” would just add unnecessary complexity. Accordingly, there is no evidence of motivation to provide for the asserted combination of Modler, Bonifas and Chapet. Nor would such a combination provide for all of the features of Claim 73 (e.g., the incorporation of the Modler static display would result in a Bonifas “card” having a displayed value that was not switchable from one status to another).

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 73 (or dependent Claims 74-78).

Further with respect to Claims 77 and 78, we dispute the Examiner’s assertion that it *per se* obvious to include display devices in any electronic device. [page 7]. This is an improper factual finding, unsupported by any evidence. The Examiner must provide substantial evidence of a suggestion of the desirability of providing for an electronic display device in a gaming token. The Examiner also

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has not provided any evidence in support of the asserted motivation to “enhance the visual output” of a gaming token. None of the references suggests any such motivation. Nor is there is any suggestion of providing specifically for a light-emitting diode or liquid crystal display in a gaming token. The Examiner has failed to establish a *prima facie* case of obviousness of Claims 73 and 78 for at least these reasons.

15. Claim 79

Claim 79 is now independent and includes all of the limitations of canceled Claim 1.

None of the cited references, alone or in combination, suggests the feature of *in which the gaming token includes a sound emitting device, mounted in the gaming token, for emitting at least one sound indicative of a status of the gaming token*, as recited in Claim 79.

The Examiner asserts that Orus teaches this feature. We disagree. The cited portion of Orus has nothing to do *a status of the gaming token*, much less *emitting at least one sound indicative of a status of the gaming token*. It states only that a gaming token capable of making a “metallic sound” when it strikes a metal object. [Column 1, lines 65 to Column 2, line 1]. There is no suggestion in any combination of references of a gaming token indicating a status by emitting sound.

No reference suggests the desirability of providing for such a feature. The Examiner states that it would have been obvious to provide “audible feedback to players,” but there is no evidence in the cited references of such “feedback,” or how the proposed “feedback” would indicate a status of a gaming token. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 79.

C. New Claims 92-98 Contain Allowable Subject Matter

We submit that the new Claims 92-98 are consonant with the election made in response to the restriction requirement mailed September 25, 2002.

1. Independent Claim 92

New Claim 92 is independent and includes all of the limitations of canceled Claims 1 and 4.

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None of the cited references, alone or in combination, suggests the desirability of changing the value of a gaming token *wherein the detected event is insertion of the gaming token in a gaming device*, as generally recited in Claim 92.

With respect to canceled Claim 4, the Examiner asserts that Bonifas teaches this feature. [page 4]. We do not agree. Bonifas describes a process of inserting a "card" in a "card reader." [See, e.g., Column 4, lines 48-57]. This process, however, does not suggest a change to an associated value of the card; the system merely records the current value of the card at the game machine. Thus, contrary to the Examiner's assertion, Bonifas does not suggest that the associated value of the "card" changes by inserting the card at a card reader. In fact, the current value is simply copied over. The cited portion of Bonifas does not support the Examiner's assertion.

Accordingly, we submit that new independent Claim 92 contains allowable subject matter.

2. Claims 93-95

New Claims 93 and 95 are independent. Claim 94 depends from Claim 93.

None of the cited references, alone or in combination, suggests the desirability of changing the value of a gaming token *in response to determining that a player has played at least a predetermined number of plays of a game*, as generally recited in Claim 93. See, e.g., Specification, page 21, lines 22-23. Nor do the references suggest determining that a player has played a game for a predetermined period of time, much less changing a value associated with a gaming token, as generally recited in Claim 95. See, e.g., Specification, page 21, lines 22-31.

Accordingly, we submit that new Claims 93-95 contain allowable subject matter.

3. Claims 96 and 97

New Claim 96 is independent. New Claim 97 depends from Claim 96.

None of the cited references, alone or in combination, suggests the desirability of changing the value of a gaming token *in response to determining that a player has achieved a predetermined rank of hand at least two times*, as generally recited in Claim 96. See, e.g., Specification, page 23, lines 26-29.

Accordingly, we submit that new Claims 96 and 97 contain allowable subject matter.

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New Claim 98 is independent.

None of the cited references, alone or in combination, suggests the desirability of changing the value of a gaming token *in response to determining that the gaming token has been taken out of a room by the player*, as generally recited in Claim 98. See, e.g., Specification, pages 23-24 (bridging sentence).

Accordingly, we submit that new independent Claim 98 contains allowable subject matter.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims 6-9, 73-85, and 88-98.

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It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

E. Petition for Extension of Time to Respond

We hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

August 6, 2004

Date



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